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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER HENDRICKSON, S

ART UNIT 1754	PAPER NUMBER 30
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DATE MAILED: 12/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/870,591

Applicant(s)
Esch et al.

Examiner
Stuart Hendrickson

Group Art Unit
1754



☒ Responsive to communication(s) filed on Nov 2, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

It is noted that in claim 1, lines 7-8, "ml ... pH of 7" should be rewritten to indicate the standard test used. In line 12 of claim 1, V_1 and V_2 should be defined; perhaps the terms "micropores" and "mesopores", or the actual pore sizes, should be recited in the claims.

Claims 1 and 7 are rejected under 35 U.S.C. § 103 as obvious over Lagarde et al.

The reference teaches in col.2 lines 5-35 and col.9 lines 1-10 silica having BET 242, CTAB 237, BET/CTAB=1.02. The pore and silanol density properties claimed but not discussed by Lagarde are deemed possessed by the product of Lagarde since the BET, CTAB and the ratio thereof are indicative of the structure of the material and are the same as claimed.

Lagarde differs in the "aggregate" (ie particle)size. However the general values disclosed in col. 2 lines 1-35, of a particle size of essentially less than 45 microns subsumes the claimed size range.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results, see In re Aller et al., 105 U.S.P.Q. 233.

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Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al. (4681750).

Johnson teaches in col. 2 line 25-col. 3 line 5 and col. 5 lines 35-68 precipitated silica having BET in the claimed range, made in a manner substantially the same as disclosed. An alkali silcate is acidified at the disclosed temperature to the same pH, continuing the reaction for a desired time period and acidifying again to the same disclosed lower pH. The product is then washed and dried, as disclosed. Even though the claimed physical properties are not disclosed by Johnson, the product thereof is deemed to possess them nonetheless since it was made in essentially the same manner as instantly disclosed.

Note that where the examiner has evidence that the product of the reference is the same as claimed but cannot determine whether all the properties are possessed, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

Applicant's arguments filed 11/2/98 have been fully considered but they are not persuasive.

The claims do not require rubber nor recite the alleged unexpected results. The Declaration versus Lagarde does not show that the difference is due to a claimed feature. Concerning Johnson, the disclosure thereof is not limited to claim 1 thereof. The claims are not to a process and the argument that the pH is kept at 7.5-10.5 is not persuasive in view of specification pg. 12 line 9. The patentable difference between a

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two step processs versus a "one" step process in which the same two things are done is not seen- especially considering that a process is not claimed. While the Declaration shows a different DBP value for example 1 of Johnson, the other properties are very similar. It is respectfully requested that applicant show that the (lower area) product of ex. 2 of Johnson does not meet the claimed parameters. Note that arguments with repect to compounding in rubber are not persuasive as this is not claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



**STEVEN BOS
PRIMARY EXAMINER
GROUP 1100**